

## Question Q217

**National Group:** AIPPI Belgium

**Title:** **The patentability criteria for inventive step / non-obviousness**

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### Questions

The Groups were invited to answer the following questions under their national laws.

#### Preliminary remark

The Belgian Office for Intellectual Property (OPRI/DIE) does not substantively examine the inventive step/non-obviousness.

However, Article 21, §2 Belgian Patent Act (BPA) provides that "A search report in respect of the invention shall be drawn up as a result of the patent application. The search report shall be drawn up by an intergovernmental body designated by the King." This search report is drawn up by the European Patent Organisation (EPO) together with an opinion on the validity. This search report merely aims to inform the patent applicant, but does not prevent the automatic granting of a Belgian patent provided the formal requirements of the patent filing are fulfilled. The courts finally decide on the inventive step/non-obviousness in case the validity of the patent is disputed in the framework of judicial proceedings.

#### **I. Analysis of current legislation and case law**

##### **a) Level of inventive step / non-obviousness**

- 1. What is the standard for inventive step / non-obviousness in your jurisdiction? How is it defined?**

The standard for inventive step is stated in Article 6 of the BPA “*An invention shall be considered as involving an inventive step if having regard to the state of the art, it is not obvious to a person skilled in the art.*” This standard is similar to the one defined by Article 56 EPC.

**2. Has the standard changed in the last 20 years? Has the standard evolved with the technical / industrial evolution of your jurisdiction?**

The former Belgian Patent Act of 24 May 1854 has been replaced with the Law of 28 March 1984. The former law remained applicable until 31 December 1986. This means that this 1854 Act does not apply anymore, except for some patents that could have been extended by a Supplementary protection certificate for medicinal products.

Since the 1984 BPA, the standard has not evolved.

The recent Law of 10 January 2011 (the 2011 Law) amending the BPA has brought no modification to this standard.

**3. Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines?**

The Belgian patent-granting authority, the Belgian Office for Intellectual Property (OPRI/DIE) does not substantively examine the inventive step/non-obviousness. Therefore, it does not publish any guidelines.

Sometimes, but this is not mandatory, Belgian Courts refer to the EPO Guidelines and BoA case law.

**4. Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings?**

No. The Belgian Office for Intellectual Property (OPRI/DIE) does not substantively examine the inventive step/non-obviousness (cf. preliminary remark).

The standards applied by Belgian courts increasingly refer to EPO guidelines, explicitly or implicitly (*Court of Appeal of Brussels, 16 June 2006, Ing.-Cons., 2006, p.503-518; Civ. Court Brussels, 28 November 2008, IRDI, 2009, 147*)

b) Construction of claims and interpretation of prior art

**5. How are the claims construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art?**

The invention has to be interpreted based on the claims, but the description and drawings are taken into consideration: “The extent of the protection conferred by the patent shall be

determined by the claims. Nevertheless, the description and the drawings shall be used to interpret the claims. For the determination of the extent of the protection conferred by the patent, any element equivalent to an element present in the claims are taken into consideration" (Article 26 BPA, as modified by the 2011 Act).

The reference person is "the person skilled in the art".

The prosecution file can be taken into consideration in the event that the wording of the claims is unclear or if, during prosecution, clear and unambiguous statements were made with regard to claim construction (*Peeters, R. and Vandermeulen, B., "De equivalentieleer in de Belgische octrooirechtspraak", I.R.D.I., 2003, liv.2, 131-137; De Preter, C., Roos, K., "De interpretatie van octrooien aan de hand van het verleningsdossier en andere extrinsieke elementen. Mag wie A heeft gezegd naderhand nog B zeggen ?", I.R.D.I., 2008, p. 134-148; Van Lint, K., "Het verleningsdossier van Europese octrooien als instrument in procedures voor de Belgische rechtbanken", in Liber Amicorum Ludovic De Gryse, Larcier, 2010, p.301-309*).

**6. Is it possible to read embodiments from the body of the specification into the claims?**

Yes, provided that these embodiments fall within the scope of the claims.

**7. How is the prior art interpreted? Is it read literally or interpreted as would be understood by a person skilled in the art? Is reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted?**

Any feature implicitly (but directly and unambiguously) disclosed in a prior art document is taken into consideration for novelty.

In relation to inventive step, prior art can be interpreted taken into account common general knowledge, in accordance with the EPO guidelines: "*The "person skilled in the art" should be presumed to be a skilled practitioner in the relevant field, who is possessed of average knowledge and ability and is aware of what was common general knowledge in the art at the relevant date*" (Guidelines for examination in the EPO, part C, IV, 11.3).

**8. Do the answers to any of the questions above differ during examination versus during litigation?**

No. The Belgian patent-granting authority does not substantively examine the inventive step/non-obviousness. (cfr. preliminary remark)

c) Combination or modification of prior art

9. **Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference? If yes, and assuming the claim is novel over the prior art reference, what is required to provide the missing teaching(s)? Is argument sufficient? Is the level of the common general knowledge an issue to be considered?**

Belgian courts can find lack of inventive step over a single prior art reference.

Typically an argument based on the prior art reference in combination with common general knowledge has to be demonstrated, for instance by reference to standard textbooks.

The level of the common general knowledge will need to be determined as the common general knowledge level of the skilled person in the art – in certain cases a team may be taken into consideration.

10. **What is required to combine two or more prior art references? Is an explicit teaching or motivation to combine required?**

There are no specific rules under Belgian law applying to this issue.

In view of the fact that Belgian courts increasingly apply EPO guidelines and BoA case law, reference can be made to EPO practice which requires that the combination of prior art disclosures would have been obvious to the skilled person seeking to solve the problem underlying the claimed invention (*Case law of the Boards of Appeal of the European Patent Office*, 6<sup>th</sup> ed. 2010, I.D.8.7, p.201).

11. **When two or more prior art references are combined, how relevant is the closeness of the technical field to what is being claimed? How relevant is the problem the inventor of the claim in question was trying to solve?**

There are no specific rules under Belgian law applying to this issue.

Belgian courts usually apply, implicitly or explicitly, EPO guidelines and BoA case law on the problem-solution-approach.

12. **Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness? Is the standard different from when only two references are combined?**

There are no specific rules under Belgian law applying to this issue. A combination of more than two references is, in principle, possible to the extent that such combination would have been obvious to the person skilled in the art.

Belgian courts usually apply, implicitly or explicitly, EPO guidelines and BoA case law on the problem-solution-approach.

- 13. Do the answers to any of the questions above differ during examination versus during litigation?**

No. The Belgian patent-granting authority does not substantively examine the inventive step/non-obviousness. (cfr. preliminary remark)

- d) Technical Problem

- 14. What role, if any, does the technical problem to be solved play in determining inventive step or non-obviousness?**

There are no specific rules under Belgian law applying to this issue.

Belgian courts usually apply, implicitly or explicitly, EPO guidelines and BoA case law on the problem-solution-approach.

- 15. To what degree, if any, must the technical problem be disclosed or identified in the specification?**

The technical problem does not have to be disclosed or identified in the specification, taking into consideration the fact that the objective technical problem may not be what the applicant presented as "the problem" in his application. A reformulation of the technical problem is possible, and any effect provided by the invention may be used as a basis for the reformulation of the technical problem, as long as said effect is derivable from the application as filed.

Belgian courts usually apply, implicitly or explicitly, EPO guidelines and BoA case law on the problem-solution-approach.

- e) Advantageous effects

- 16. What role, if any, do advantageous effects play in determining inventive step or non-obviousness?**

Technical advantageous effects can be taken into account when evaluating inventive step, but cannot substitute the concrete evaluation of inventive step on the basis of problem-solution approach. However, note that there is no legal provision requiring the application of the problem-solution approach for determining lack of inventive step.

**17. Must the advantageous effects be disclosed in the as-filed specification?**

No.

**18. Is it possible to have later-submitted data considered by the Examiner?**

The Belgian national patent authority does not examine the inventive step/non-obviousness (cfr. preliminary remark).

At the level of the European Patent Office the Examiner may take into account later-submitted data.

**19. How “real” must the advantageous effects be? Are paper or hypothetical examples sufficient?**

If technical advantages are taken into consideration, the advantageous effects have to be recognizable for the man skilled in the art. Paper or hypothetical examples illustrating the advantageous effects may be sufficient provided that the examples can be readily understood by the skilled person.

Cfr. also EPO Guidelines C, IV, 1.3.

**20. Do the answers to any of the questions above differ during examination versus during litigation?**

No. The Belgian national patent authority does not substantively examine the inventive step/non-obviousness (cfr. preliminary remark).

f) Teaching away

**21. Does your jurisdiction recognize teaching away as a factor in favour of inventive step / non-obviousness? Must the teaching be explicit?**

Teaching away is typically taken into consideration, if (1) the person skilled in the art has knowledge of the element which teaches away; and (2) if the teaching away is based on a “technical” consideration (not simply a teaching away for commercial purposes).

Cfr. also EPO Guidelines C, IV, 1.3

**22. Among the other factors supporting inventive step / non-obviousness, how important is teaching away?**

Teaching away can constitute an important element in supporting the inventive step.

Cfr. also EPO Guidelines C, IV – Annex, No. 4.

**23. Is there any difference in how teaching away is applied during examination versus in litigation?**

No. The Belgian national patent authority does not substantively examine the inventive step/non-obviousness (cfr. preliminary remark).

g) Secondary considerations

**24. Are secondary considerations recognized in your jurisdiction?**

Yes.

A. *If yes, what are the accepted secondary considerations?*

- The fact that one unexpectedly obtains a technical effect (*Court of Appeal of Antwerp, 28 June 2004, R.G. 2003/1531*).
- The recognition by the scientific community of the merits of the inventor.
- The advantageous technical effect of the invention (*Court of Appeal of Brussels, 15 October 2009, R.G. 2006/3172; Civil Court of Brussels, 3 February 2006, R.G. 2005/863/A*).
- The fact that the invention solves a technical problem which professionals in the concerned domain tried to solve for a long time (*Court of Appeal of Brussels, 28 April 2009, R.G. 2007/AR/137; Civil Court of Liège, 6 December 2007, I.C.I.P., 2008, p.118; Civil Court of Liège, 7 January 2005; I.R. D.I., 2005, p.157*).
- The seniority of the closest prior art (*Court of Appeal of Brussels, 28 April 2009, R.G. 2007/AR/137*).
- The fact that the invention contradicts a prevalent technical prejudice (*Civil Court Brussels, 3 February 2006, A.R. 2005/863/A*).
- ... (cfr. EPO Guidelines C, IV, 11.10).

B. *How and to what degree must they be proven? Is a close connection between the claimed invention and the secondary considerations required?*

Secondary considerations are typically used to reinforce the arguments to demonstrate the inventive step. These secondary considerations must, however, be proven. A sufficiently close connection between the claimed invention and the secondary considerations is thus required.

- 25. Do the answers to any of the questions above differ during examination versus during litigation?**

No. The Belgian national patent authority does not substantively examine the inventive step/non-obviousness (cfr. preliminary remark).

- h) Other considerations

- 26. In addition to the subjects discussed in questions 4 - 26 above, are there other issues, tests, or factors that are taken into consideration in determining inventive step / non-obviousness in your jurisdiction? If yes, please describe these issues, tests, or factors.**

Cfr. EPO Guidelines C, IV, 11.10.

- i) Test

- 27. What is the specific statement of the test for inventive step/non-obviousness in your jurisdiction? Is there jurisprudence or other authoritative literature interpreting the meaning of such test and, if so, provide a brief summary of such interpretation.**

The test for inventive step/non-obviousness is in principle the problem-solution-approach as applied by the European Patent Office, although it is not mandatory to apply this test for inventive step/non-obviousness. (Cfr. Case Law of the Boards of Appeal of the EPO, 2010, p. 163)

- 28. Does such test differ during examination versus during litigation?**

No. The Belgian national patent authority does not examine the inventive step/non-obviousness (cfr. preliminary remark).

- j) Patent granting authorities versus courts

- 29. If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.**

The Belgian national patent authority does not examine the inventive step/non-obviousness (cfr. preliminary remark).

- 30. Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?**

The Belgian national patent authority does not examine the inventive step/non-obviousness (see preliminary remark).



k) Regional and national patent granting authorities

**31. If you have two patent granting authorities covering your jurisdiction, do they diverge in their approach to inventive step / non-obviousness?**

In contrast to the European Patent Office, the Belgian patent office does not perform substantive examination of the patent application. The burden of proof of obviousness rests, both for Belgian patents and for the Belgian tier of European Patents, with the party invoking invalidity.

**32. If yes, is this problematic?**

Not applicable.

## **II. Proposals for harmonization**

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the patentability criteria for inventive step / non-obviousness. More specifically, the Groups are invited to answer the following questions without regard to their national laws:

**33. Is harmonization of inventive step / non-obviousness desirable?**

Yes, first at the level of the European Union and subsequently world wide.

**34. Is it possible to find a standard for inventive step / non-obviousness that would be universally acceptable?**

Yes.

**35. Please propose a definition for inventive step / non-obviousness that you would consider to be broadly acceptable.**

We would propose a definition similar to alternative A of article 18 of the draft SPLT which bears the closest resemblance to the EPC, in particular: "An invention shall be considered to involve an inventive step (be non-obvious) if, having regard to the prior art, it would not have been obvious to a person skilled in the art at the filing date or, where priority is claimed, the priority date of the application claiming the invention".

**36. Please propose an approach to the application of this definition that could be used by examiners and by courts in determining inventive step / non-obviousness.**

The Belgian Section of the AIPPI considers that there is no one-size-fits-all approach. Even though the problem-solution approach is one possible approach, and the most often used in the member states of the EPC, the examiner or the courts should have the possibility to choose the approach he considers the most suitable to examine the inventive step/non obviousness, on the condition that the examiner or the courts motivate the choice of a particular approach.

## **Summary**

With respect to the first set of questions (“Analysis of current legislation and case law”), the Belgian group recalls that there does not exist, in relation to inventive step, own case law of the Belgian Office for Intellectual Property (Office Belge pour la Propriété Intellectuelle (“OPRI”) – the authority instituted to grant Belgian patents). In fact, Belgian patents are granted by the OPRI without a substantive examination of the patentability conditions. The Belgian procedure does however provide for a search report and a written opinion on the patentability/validity which is delivered by the European Patent Office (EPO) in relation to Belgian patent applications, but these reports only have an informative value. Other than that, the Belgian legislation in relation to inventive step is similar to the European Patent Convention, and the Belgian jurisprudence tends to apply, implicitly or explicitly, the guidelines of the EPO in this respect. Except for the elements which relate to the evolution of Belgian legislation, the present report refers, therefore, to a large extent to the guidelines of the EPO, while supplementing it with some relevant references to Belgian case law.

With respect to the second set of questions (“Proposals for harmonization”), the Belgian group feels that it could be possible to find a universal definition, and formulates a proposition of definition. However, the Belgian group considers that different approaches are possible in relation to the concrete application of this definition by the examiners or jurisdictions.

## **Résumé**

Pour ce qui concerne le premier volet de questions (« Analysis of current legislation and case law »), le groupe belge rappelle qu’il n’y a pas, en matière d’activité inventive, de jurisprudence propre de l’Office Belge pour la Propriété Intellectuelle (OPRI - l’autorité chargée de la délivrance des brevets belges). En effet, les brevets belges sont délivrés par l’OPRI sans examen de fond des conditions de brevetabilité. La procédure belge prévoit toutefois qu’un rapport de recherche et une opinion écrite sur la brevetabilité sont délivrés par l’Office européen des brevets (OEB) pour les demandes de brevets belges, mais ils ne valent qu’à titre d’information. Pour le reste, la législation belge en matière d’activité inventive est similaire à la Convention sur le brevet européen, et la jurisprudence belge applique, implicitement ou explicitement, les directives de l’OEB en la matière. Sauf pour ce qui concerne des éléments ayant trait à l’évolution de la législation belge, le présent rapport renvoie donc pour l’essentiel aux directives de l’OEB, en y ajoutant les références pertinentes de jurisprudence belge.

Pour ce qui concerne le deuxième volet de questions (« Proposals for harmonization »), le groupe belge estime qu'une définition universelle de l'activité inventive peut être trouvée, et formule une proposition de définition. Cependant, le groupe belge estime que différentes approches sont possibles pour ce qui concerne l'application concrète de cette définition par les examinateurs ou les juridictions.